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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,083	04/04/2001	Bruce Royer	57111-5094	3868

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JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES, CA 90067

EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,083

Applicant(s)

ROYER ET AL.

Examiner

James S McClellan

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-48 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Request for Reconsideration

1. Applicant's submission of a Request for Reconsideration on June 28, 2004 has been fully considered, wherein claims 1-48 remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, laws of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

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In this case, claim 18 fails to recite the use of technology to perform the process. Claim 18 as originally filed can be performed manually. The Examiner recommends amending 18 to include language similar to claim 1, that includes the recitation of a network or computer.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-13, 15, 17-24, 26-30, 32, 34-37, 40-44, 46, and 48 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,892,905 (hereinafter “Brandt”).

Brandt discloses a system and method for accessing rental equipment reservation software applications via the world-wide web, including the steps of: displaying reservation summary having reservation data (i.e. car preference, origin city, etc.) and vehicle type information (see column 23, lines 64-67); tracking equipment inventory (see column 23, lines 30-40); making confirmation of reservation (see column 28, lines 60-63); updating reservation information (see column 32, lines 47-48); searching equipment inventory (see paragraph bridging columns 29-30); and displaying customer information and customer history information(see column 31, lines 7-11).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 9, 23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of Internet Publication to Ryder (hereinafter "Ryder").

If it is held that fails to inherently disclose displaying route selection information selected from one-way and in-town, then Ryder is relied upon to teach one-way truck rental (see page 2, "Save 10% on All One-Way Rentals").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with the display of one-way or in-town route information as taught by Ryder, because it is important for vehicle inventory tracking to determine if a rental truck will be returned to the original vendor or a different vendor.

7. Claims 8, 25, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 6,266,277 (hereinafter "Craig").

Brandt fails to expressly disclose alerting the user of upon the detection of an update failure.

Craig teaches the use of a system alerting the user of upon the detection of an update failure (see paragraph bridging columns 7-8).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with update alert failures as taught by Craig, because update alert failure notifications allows the user to determine when updates have problems.

8. Claims 14, 31, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 6,085,976 (hereinafter "Sehr").

Brandt fails to expressly disclose displaying payment information.

Sehr teaches the use of displaying payment information (see column 16, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with payment information display as taught by Sehr, because it is advantageous for vehicle rental vendors to know if a customers has paid for the rental before the customer leaves with the vehicle.

9. Claims 16, 33, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 5,344,172 (hereinafter "Jaun").

Brandt fails to expressly disclose verifying compatibility between a requested towing combination.

Jaun teaches that different towing combinations have varying towing capacities (see column 1, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with verifying towing combinations as taught by Jaun, because improper towing combinations can damage the rental equipment and possibly cause physical harm to the users.

Response to Arguments

10. Applicant's arguments filed June 28, 2004 have been fully considered but they are not persuasive.

On page 2, final paragraph (continued on page 3), Applicant argues that the claims 18-34 are statutory despite the case law relied upon by the examiner. Applicant asserts that claim 1 of AT&T, fails to include technology in the body of the claim. As set forth in the previous response to arguments, the invention in the body of the claim must be tied to technological art, environment, or machine, or the claim is not statutory. In AT&T, the body of the claim is clearly tied to the technology stated in the preamble. For example, the body of the claim includes limitations relating to an "interexchange call" between subscribers. An interexchange call is art specific terminology in the telecommunications industry that clearly has ties to the "telecommunications system" that is set forth in the preamble. Since the body of the claim includes ties to technology, the claim is statutory. However, Applicant's claims 18-34 fail to include a recitation of technology in either the preamble or the body of the claims.

On page 4.(also page 5, claim 35) Applicant argues that Brandt fails to disclose "displaying a reservation summary having reservation information pertaining to the type of equipment reserved and the date of reservation. The Examiner respectfully disagrees. As broadly claimed, the user input screen provides a summary the reservation (see column 23, lines 64-67). Additionally, even if the user input screen isn't considered a reservation summary, it would be inherent that user receive verification of the date and type of equipment reserved. Otherwise, the user would not know when and what to pick up.

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On page 5, second full paragraph, Applicant argues that Brandt fails to disclose a search field that includes a search request window. The Examiner respectfully disagrees. As noted by Applicant, Brandt discloses search for equipment in the paragraph bridging columns 29-30. As broadly claimed, the Examiner asserts that is inherent that the search is entered into a “search window”, wherein a window is merely a portion of a graphical user interface screen that can contain its own document or message. In this case, the “search window” is the portion of the GUI where the user inputs the search request.

On page 6, first paragraph, Applicant argues that the Ryder flyer does not cure the alleged deficiencies of Brandt to disclose a reservation summary. As set forth above, it is the Examiner’s position that Brandt discloses a reservation summary.

In response to Applicant's argument on page 6, second paragraph, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is drawn from knowledge generally available to one of ordinary skill in the art. As set forth above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with the display of one-way or in-town route information as taught by Ryder, because it is important for vehicle inventory tracking to determine if a rental truck will be returned to the original vendor or a different vendor.

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On page 7, Applicant argues that Craig is not related to equipment reservation therefore does not properly teach alerting users when the system fails to update reservation information. The Examiner respectfully disagrees. Craig is merely relied upon to disclose alerting a user during an update failure. In this case, the type of update (reservation or firmware) that causes the alert is immaterial because Brandt, not Craig, is relied upon to disclose reservation information.

On page 8, Applicant once again argues that the secondary reference (in this case, Sehr) is non analogous to the primary reference (Brandt's vehicle reservation system). The Examiner respectfully disagrees. Sehr, like Brandt, is directed to electronic commerce. The type of commerce is irrelevant. A payment system for electronic commerce is not dependent on the type of commerce.

On page 9, Applicant once again argues that the secondary reference (in this case, Jaun) is non analogous to the primary reference (Brandt's vehicle reservation system). The Examiner respectfully disagrees. Jaun, like Brandt, is directed to vehicles. Jaun teaches that an important characteristic of a vehicle is the towing capacity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with verifying towing combinations as taught by Jaun, because improper towing combinations can damage the rental equipment and possibly cause physical harm to the users.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

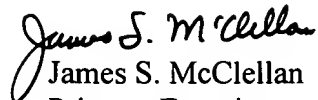
Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
September 21, 2004